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10/717,523	11/21/2003	Martin Josso	016800-586	8425

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EXAMINER

ALSTRUM ACEVEDO, JAMES HENRY

ART UNIT	PAPER NUMBER
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1616

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06/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/717,523

Applicant(s)

JOSSO, MARTIN

Examiner

James H. Alstrum-Acevedo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-27, 29, 30, 32-55, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-27, 29, 30, 32-55, 57 and 58 is/are rejected.
- 7) ☒ Claim(s) 3-27, 29, 32-55, and 57-58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 3-27, 29-30, 32-55, and 57-58 are pending. Applicants' previously cancelled claims 2, 28, 31, and 56. Applicants have amended claims 12 and 41. Receipt and consideration of the remarks/arguments and claim amendments in the reply filed on January 25, 2007 are acknowledged.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 26, 2007 has been entered.

Specification

The incorporation of essential material in the specification by reference to an unpublished U.S. application, **foreign application or patent**, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f). Specifically, the instant specification incorporates by reference a variety of foreign patent

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documents (e.g. EP 0832642 or DE10162844) by reference to provide the definition for or examples of suitable derivatives of UV-screening agents [i.e. see paragraph [0030] in the PG-PUB of the instant application]. One of the U.S. patent documents listed in paragraph [0030] to provide this information contains no information whatsoever about UV-screening agents, but rather describes a device for passing an electric current between electrodes (i.e. U.S. Patent No. 4,367,390). It is unclear how a disclosure concerning a device for passing an electric current between electrodes is suitable for providing adequate disclosure of suitable examples of the variety of derivative alluded to in the instant specification or to provide definitions setting forth the metes and bounds of said derivatives. The only other U.S. patent document incorporated by reference regarding what constitutes suitable examples of the various derivatives alluded to in Applicant's specification is U.S. Patent No. 2,463,264, which is limited solely to the preparation of water-soluble benzimidazole compounds.

Claims 3-27, 29, 32-55, and 57-58 are objected to because of the following informalities: (1) the word "claim" is improperly capitalized in said claims; (2) in claims 13 and 42 the names of chemical compounds are improperly capitalized; and (3) in line 7 of claim 42 the name of the compound bridging lines 7-8 beginning with "2,4,6-Tris..." has a box inserted in the chemical name, which appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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The rejection of claims 12 and 41 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is maintained** for the reasons of record as set forth on page 4 of the office action mailed on November 30, 2005 and further explained below.

Response to Arguments

Applicant's arguments filed January 25, 2007 have been fully considered but they are not persuasive. Applicants have traversed the instant rejection by asserting that a person of ordinary skill in the art at the time of the instant invention would understand that the term "bisbenzoazolylys" includes the bis-benzoazolyyl derivatives described in EP-669323 and U.S. Patent No. 2,463,264. This argument is found unpersuasive, because as Applicants implicitly admit, the teachings of EP-669323 and U.S. Patent No. 2,463,264 would only teach enough for a person of ordinary skill in the art to ascertain a small subset of compounds encompassed by the term bisbenzoazolylys (i.e. "includes..."). Furthermore, if an ordinary skilled artisan would need to consult EP 669323 to ascertain the metes and bounds of bisbenzoazolylys this would be an improper incorporation by reference of essential information by reference to a foreign patent document. Thus, an ordinary skilled artisan would not be apprised of the complete metes and bounds of the term bisbenzoazolylys, which is understood as being equivalent to bisbenzoazolyyl derivatives.

Claims 12-13, 21-22, 41-42, and 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims 12, 21, 41, and 49 are indefinite because these refer to the derivatives of various classes of chemical compounds, including "dimers derived from alpha-alkylstyrene." The term derivative, in general, and/or how it may apply to the different classes of chemical compounds recited in the rejected claims is not defined in the specification. It is noted that Applicants refer, primarily to foreign patent documents, which are incorporated by reference, to allegedly set forth what is meant by said derivatives. It is also noted that several examples of these derivatives are given, however, examples are not definitions, because examples do not clearly set forth the metes and bounds of a term. The 10th edition of the Merriam-Webster's Collegiate Dictionary (Merriam-Webster Incorporated: Springfield, Massachusetts, 1993, pp 311) defines "derivative" as, "a chemical substance related structurally to another substance and theoretically derivable from it." For example, carbon dioxide could theoretically be derived from the combustion of camphor. Therefore, the definition of derivative in the Merriam-Webster Collegiate Dictionary does not shed light on what Applicants' intended for the meaning of the various derivatives of the various chemical classes of compounds recited in the above rejected claims.

The remaining claims are rejected for depending upon a rejected claim.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The rejection of claims 1, 3-6, 9-18, 25, 29-30, 32-46, 53, and 58 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Fankhauser et al. (US 2002/0155073) is **maintained** per the teachings/disclosures set forth on pages 5-6 and 10-11 of the office action mailed on November 30, 2005 and page 4 of the office action mailed on May 12, 2006.

The rejection of claims 1, 3-12, 14-25, 29-30, 32-41, and 47-52 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) in view of Torgerson et al. (U.S. Patent No. 6,458,906) is **maintained** per the disclosures/teachings set forth on pages 5-6 and 11-13 of the office action mailed on November 30, 2005 and pages 4-5 of the office action mailed on May 12, 2006.

The rejection of claims 26-27, 54-55, and 57 under 35 U.S.C. 103(a) as being unpatentable over Iijima et al. (U.S. Patent No. 6,258,857) ("Iijima") in view of Torgerson et al. (U.S. Patent No. 6,458,906) ("Torgerson") as applied to claims 1, 3-12, 14-25, 29-30, 32-41, and 47-52 above, and further in view of Candau, D. (U.S. Patent No. 6,033,648) ("Candau") **is maintained** per the teachings set forth on pages 5-6 and 11-14 of the office action mailed on November 30, 2005 and pages 4-5 of the office action mailed on May 12, 2006.

Response to Arguments

Applicant has traversed the art rejections of record based on the following arguments: the prior art does not disclose, teach, or fairly suggest (1) a device comprising (a) an emulsion and (b) a photoprotective system; (2) a means to place said composition under pressure; (3) there is not motivation in the prior art teachings to combine the references relied upon in the previous office action; and (4) Applicant has alleged a showing of unexpected results based upon additional experimental evidence. The Examiner respectfully disagrees with Applicant's arguments traversing the art rejections of record.

Regarding the Applicant's last argument, the data submitted in tabular form along with the arguments/remarks has not been considered, because said data was not provided in the form of an oath or declaration. The MPEP (See 37 C.F.R. § 1.132) clearly states,

§ 1.132 Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

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Even if Applicants' data were in proper form, it would not have been found persuasive. Applicant has attempted to compare data for an alleged composition of U.S. Patent No. 6,258,857 (Iijima) and the instant application. It is unclear how Applicant obtained the alleged "prior art composition." It appears that Applicant's "prior art" composition does not reflect any exemplified embodiment in the prior art reference and ignores the specific teachings cited concerning said reference. For example, the alleged prior art composition lacks a surfactant, despite the clear teaching by Iijima that a surfactant is preferred to help with the dispersion and the citation of self-emulsifying surfactants as suitable surfactants (col. 12, lines 60-64 and column 13, lines 40-42). It also noted that the relative amounts of alcohol and water in the alleged "prior art" composition do not agree with the amounts in Iijima's exemplified embodiments or teachings of preferred relative amounts of water and alcohol. It seems like Applicant selectively picked from the teachings of Iijima while ignoring others to obtain a composition that would support Applicant's arguments. Therefore, the compositions compared are not a fair comparison representing compositions taught by the prior art and those claimed by Applicant and would have been found unpersuasive if considered.

Applicant's arguments (1) and (2) will be addressed together because all references utilize Iijima as the primary reference and the teachings of Iijima are sufficient to rebut Applicant's arguments. Iijima clearly teaches (see the abstract for example) (1) a composition contained in a releasing container such as an aerosol container or pump type-releasing container, and used as being released from such releasing container, and (2) a releasing container product containing such composition (see column 1, lines 7-11). It is known in the art that aerosol containers routinely contain pressurized formulations and therefore said formulations

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within such an aerosol container would obviously have a means of placing a composition under pressure, because the compositions are already under pressure. Applicant also admits in paragraph [0115] of the instant specification that aerosol containers are well known to persons of skill in the art as devices that are in accordance with Applicant's invention. Therefore, these specific limitations are addressed by the teachings of Iijima alone. Iijima also teaches that the compositions may comprise an ultraviolet blocker, which constitutes a photoprotective system (abstract, col. 7, lines 15-27). Notwithstanding this, the combination of the teachings of Iijima and Fankhauser or Iijima and Torgerson most assuredly do yield compositions comprising a photoprotective system (See, for example: Fankhauser paragraphs [0007], [0065], [0099], and [0139]; or Torgerson, col. 18, lines 5, 19-21, and Example XIX). Iijima alone and in combination also teaches emulsions, as was clearly articulated on page 8 of the previous office action mailed on May 12, 2006 (See also: Iijima, col. 12, lines 60-64 and col. 13, lines 40-42; Fankhauser, [0250]; Torgerson, col. 15, lines 50-61; and Candau, col. 11, lines 1-10).

The motivations to combine the secondary and ternary references of record with Iijima are further articulated herein. A skilled artisan would have been motivated to combine the teachings of Iijima with the teachings of Fankhauser at least because, particularly in Asiatic countries, there is great interest in light protection filters or mixtures of light protection filters which preserve the color of the skin following solar irradiation and, moreover, are able to impart a lighter appearance to the skin and Fankhauser's compositions provide this desired property (Fankhauser, [0003]). Furthermore, both Fankhauser and Iijima are generally in the same field of endeavor of cosmetic products with UV protecting properties. The fact that Iijima's invention has other utilities does not constitute a teaching away.

A skilled artisan would have been motivated to combine the teachings of Iijima with the teachings of Torgerson at least because Torgerson's invented copolymers provide topical compositions which (1) are more easily and uniformly spread upon the skin; (2) feel good upon the skin, and yet which are highly substantive; (3) are useful for enhancing the penetration of a wide variety of cosmetic and pharmaceutical actives into the skin; and (4) alternatively, through the skin for systemic delivery (col. 2, lines 5-11). The combination of Iijima and Torgerson would therefor yield compositions having desirable properties of a good feel, ease and uniformity upon application, and enhancement of the penetration of cosmetic/pharmaceutical actives, if desired.

A skilled artisan would have been motivated to combine the teachings of Iijima and Torgerson with the teachings of Candau at least because Candau's compositions comprising iron oxide nanopigments, formulated into a water-in-oil emulsion vehicle, diluent or carrier, impart to the skin, a few minutes after application thereto, an artificial coloring similar to natural tanning which is simultaneously intense, non-covering, transparent, persistent over time, and particularly resistant to water (col. 2, lines 25-34). The combination of Iijima and Torgerson with Candau would therefor yield compositions having desirable artificial tanning properties that impart to the skin a coloring that is transparent, persistent over time, and particularly resistant to water.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The provisional rejection of claims 1, 3, 4, 9-12, 14-17, 30, 32-33, 38-41, and 43-46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6-15, 29, and 30 of copending Application No. 10/365,653 (copending '653) **is maintained** for the reasons of record set forth on pages 6-7 of the office action mailed on May 12, 2006 and because Applicants' have requested that this rejection be held in abeyance.

Conclusion

Claims 1, 3-27, 29-30, 32-55, and 57-58 are rejected. Claims 3-27, 29, 32-55, and 57-58 are objected. No claims are allowed.

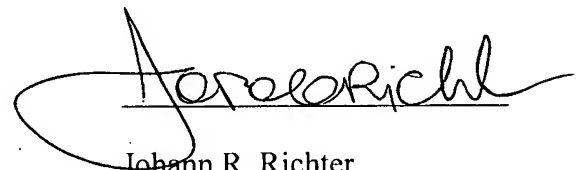
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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